

REMARKS

By this amendment, claim 1 is amended as discussed below; and claims 2-7, 12, 15 and 18 are canceled. Claims 1, 9, 16 and 17 are pending. Support can be found in the specification as filed, for example as described in the previous claim set; at pages 8 and 9; and at pages 18 and 19. See also page 11. No issue of new matter arises.

Rejections under 35 U.S.C. §112

Second paragraph

Claims 1-7, 9, 12, 15-18 were rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite "for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention." Claims 2-7, 12, 15 and 18 are canceled. Claim 1 is amended to obviate the issue of improper antecedent basis. Claims 9, 16 and 17 depend from claim 1 and thus the claim 1 amendment obviates rejections of these claims. Reconsideration and withdrawal of this rejection are respectfully requested.

First paragraph

Claims 1-7, 9, 12 and 15-18 were rejected under 35 U.S.C. §112, first paragraph, as allegedly "failing to comply with the written description requirement." The Office Action asserted: "The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention."

At page 4, first paragraph, the Office Action acknowledged that the specification provided support for the example described. Claims 2-7, 12, 15 and 18 are canceled. Claim 1 is amended to feature this example. Claims 9, 16 and 17 depend from claim 1 and thus the claim 1 amendment obviates rejections of these claims. Reconsideration and withdrawal of this rejection are respectfully requested.

Rejections under 35 U.S.C. §103(a)

Claims 1-7, 9, 12 and 15-16

Claims 1-7, 9, 12 and 15-16 were rejected under 35 U.S.C. 103(a) as allegedly "being unpatentable over Seemann (Canadian Patent Application 2,062,047; laid open to the public on

8/29/1992, of record) in view of Mattes (U.S. Patent 4,859,449; issued 08/1989, of record) or Winkelhake (Winkelhake, J. Biological Chemistry, 251 (4): 1074-1080, 1976, of record) or Day et al. (Journal of Biological Chemistry 1980; 255: 2360-2365)."

Seemann was alleged to teach "a fusion protein comprising the general formula huTuMAb-L- β -gluc, wherein huTuMA is a humanized tumor-specific monoclonal antibody or fragment thereof, L is a linker and β -gluc comprises human β -glucuronidase (page 1, 1st paragraph)." Seemann is also alleged to teach "that the huTuMAb includes the antibody binding fragments of antiCEA BW431/26 monoclonal antibody (page 3, lines 16-23; page 17, lines 25+; and page 23, *Example O*)." Finally, Seemann is alleged to teach that "fusion proteins can be further modified in order to achieve an increased half-life, wherein the fusion proteins are treated with an oxidizing agent which cleaves the carbohydrate ring, e.g. chemical degradation, which can be further derivatized by reductive amination which generates a new carbohydrate residue (page 4, lines 12-30)" and "a pharmaceutical composition comprising the fusion protein".

In the paragraph bridging pages 6 and 7, the Office Action acknowledged the prior art did not teach or suggest the combination claimed, but that in view of the rejection under 35 U.S.C. §112, second paragraph, broad interpretation of the claim is the reason the rejection under 35 U.S.C. §103(a) was kept. Claims 2-7, 12, 15 and 18 are canceled. Claim 1 is amended as discussed above to obviate the 35 U.S.C. §112, second paragraph rejection. In view of cancellation of claim 18, claim 18 is not separately discussed. Claims 9, 16 and 17 depend from claim 1 and thus are patentable over the prior art for at least the same reasons that claim 1 is patentable. Reconsideration and withdrawal of these rejections are respectfully requested.

Conclusion

In view of the above amendments and remarks, Applicants respectfully request reconsideration and withdrawal of all rejections. Applicants respectfully submit that the application is now in condition for allowance and request prompt issuance of a Notice of Allowance. Should the Examiner believe that anything further is desirable that might put the application in even better condition for allowance, the Examiner is requested to contact the undersigned at the telephone number listed below.

Fees

No fees not otherwise provided for are believed to be necessitated by the instant response. However, should this be in error, authorization is hereby given to charge Deposit Account no. 18-1982 for any underpayment, or to credit any overpayments.

Respectfully submitted,

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